

IPW



PATENT
Customer No. 22,852
Attorney Docket No. 05552.1463-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Udo KRUPKA)	Group Art Unit: 1648
)	
Application No.: 10/561,345)	Examiner: Bo Peng
)	
PCT Filed: June 17, 2004)	
§ 371 Date: December 20, 2005)	
)	Confirmation No.: 5930
For: NOVEL SURFACE PROTEIN)	
(HBsAg) VARIANT OF THE)	
HEPATITIS B VIRUS)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

In a restriction requirement dated October 31, 2007, the Office required restriction, under 35 U.S.C. §§ 121 and 372 and PCT Rule 13.1, between:

- Group I: claims 24-35 and 40 in part, which the Office states are "drawn to the technical feature of a peptide of an HBsAg variant;"
- Group II: claims 36-39 and 40 in part, "drawn to the technical feature of an antibody against a peptide of claims 24, 26, 28, 29, or 31;"
- Group III: claim 41, "drawn to the technical feature of a method for detecting a hepatitis B antigen using the antibody of claim 36;" and

Group IV: claim 42, "drawn to the specific technical feature of a method for identify [sic] antibodies to a hepatitis B antigen using a peptide of claims 24, 26, 28, 29, or 31."

Applicant provisionally elects, with traverse, to prosecute Group I, claims 24-35 and 40.

The Office also required an election of species and an identification of the claims encompassing the election. Applicant provisionally elects, with traverse, SEQ ID NO:12, which may be found at page 32 of the instant application. That sequence is specifically recited in claims 28, 29, and 31, and elected claims 24-25, 28-35, and 40 encompass that sequence.

Applicant traverses this restriction and election requirement because all of the instant claims are "so linked as to form a single general inventive concept" according to PCT Rule 13.1, and because claims 24-42 all contain "the same or corresponding special technical features" under PCT Rule 13.2, and therefore possess the required technical relationship for unity of invention. Specifically, each of dependent claims 36-42, which form Groups II-IV, encompasses the oligopeptides and polypeptides of claims 24, 26, 28, 29, and 31 of Group I. (See, e.g., claims 36, 39, 40, and 42.)

Moreover, each of claims 36-42, representing Groups II-IV, is a dependent claim, and each depends from claims within the elected Group I. According to PCT Rule 13.4 and the policy of PCT Annex A of the M.P.E.P., at Part I, Section (c)(i), dependent claims that contain all of the features of the independent claims should be included in the same group, even if the dependent claims contain a further invention. Claims 36-42 each satisfy that policy as they rely upon the oligopeptides and polypeptides claimed in

claims 24, 26, 28, 29, and 31 of Group I. Moreover, if the oligopeptides and polypeptides of claims 24, 26, 28, 29, and 31 are novel and nonobvious, it follows by simple logic that their antibodies would also be novel and nonobvious, as would kits and methods making use of them. Thus, at the very least, Applicant requests the Office to rejoin all of claims 36-42 to the application upon allowance of the subject matter of elected Group I. Claim 42 may also be rejoined according to the policy of rejoining methods of use and manufacture of an elected composition claim, as the Office acknowledges in Paragraph 13 of this Office Action. (See PCT Annex A, Part I, Section (e).)

Applicant also notes that it is the Office's general policy that "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803; emphasis added.) In this case, there is no serious burden on the Office in examining all of the instant claims together because they all incorporate the subject matter of Group I. Because all of the claims of Groups II-IV are dependent on claims in Group I, a search based on the subject matter of Group I would be sufficient for all of Groups II-IV as well.

Applicant also submits that the election requirement is not necessary as a search may be made on the overall scope of claims 24-35 and 40 without undue burden. For example, each of SEQ ID NOS:13, 14, 15, 16, 17, 18, 19, 20, 21, and 22, presented at pages 32-33 of the application text are sequences that fall within the boundaries of the elected SEQ ID NO:12. In any event, Applicant expects that once the Office finds the

Application No.: 10/561,345
Attorney Docket No.: 05552.1463-00

elected species novel and nonobvious, the Office will continue the search under its policy of M.P.E.P. § 803.02.

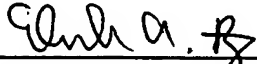
Finally, Applicant notes that the second page of this Office Action contains a notice regarding the final rules published August 21, 2007, related to claims and continuation applications. Applicant acknowledges that notice, but submits that it does not apply to this application at the present time because of the preliminary injunction staying the implementation of those rules granted by the District Court of the Eastern District of Virginia on October 31, 2007. Should some or all of those rules go into effect at a later time, Applicant will consider whether claim amendments or cancellation of certain claims would be beneficial to the prosecution of this application and any future continuation or divisional application.

Please grant any extensions of time required to enter this response and charge any required fees that are not found herewith to deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 30, 2007

By: 
Elizabeth A. Doherty
Reg. No. 50,894